



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,204	08/05/2003	Kim Marie Clark	317270.4/A02201US	6832

7590 01/09/2006

H. Roy Berkenstock
Wyatt, Tarrant & Combs, LLP
Suite 800
1715 Aaron Brenner Drive
Memphis, TN 38120-4367

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,204

Applicant(s)

CLARK, KIM MARIE

Examiner

Nasser Ahmad

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Rejections Maintained

1. Claims 1 and 5-7 rejected under 35 U.S.C. 102(b) as being anticipated by Ratzlaff (5099889) for reasons of record in the last Office Action of February 3, 2005.
2. Claims 1 and 5-7 rejected under 35 U.S.C. 103(a) as being unpatentable over Padilla (5869159) in view of Petock (3884495) for reasons of record in the last Office Action.
3. Claims 1-3 and 5-9 rejected under 35 U.S.C. 103(a) as being unpatentable over Ratzlaff in view of Simmons (5964252) for reasons of record in the last Office Action.
4. Claims 4 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Ratzlaff in view of Tomberlin (4939778) for reasons of record in the last Office Action.

Response to Arguments

5. Applicant's arguments filed October 11, 2005 have been fully considered but they are not persuasive.

Applicant argues that Ratzlaff's cover can hardly be said to be decorative. This is not deemed to be convincing because Ratzlaff's cover is shown to have a decorative feature as provided by the fibrous structure and it also provides for an aesthetically pleasing cover for the pipe.

Applicant argues that Ratzlaff's cover is not a fabric as it describes a mat of open weave construction. This is not found to be persuasive because fabric is made by weaving and Ratzlaff clearly teaches that the mat is formed by interengaged filaments (col. 4, line 4) and hence, Ratzlaff's mat is a fabric.

Art Unit: 1772

Applicant also argues that that Ratzlaff's cover is not selectively adhered for selective removal. This is not deemed to be convincing because the phrase "selectively adhered for selective removal" is not found in the claims and cannot be read thereinto for the purpose of avoiding the applied prior art. What the claim recites is that the release liner is selectively removable, which is not the same as the cover itself being selectively removable.

In response to applicant's argument that Padilla and Ratzlaff are non-analogous art and cannot be combined to show *prima facie* case of obviousness, applicant should note that none of the rejections made in the last Office Action is based on Padilla and Ratzlaff as alleged. Hence, the argument is moot.

In response to applicant's argument that the examiner's conclusion of obviousness is based on improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning . But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the invention was made, and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971). In this case, the combinations show that the various elements are known in the art.

6. In addition, the following are new grounds of rejection in view of the amendment to the claims.

Claim Rejections – 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 5, the phrase “supple” is found to be new matter as support for said phrase could not be located in the specification.

Claim Rejections – 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 5-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Weightman (4795190).

Weightman relates to a decorative cover for enveloping a linear object . the cover comprises a lengthwise strip of supple fabric (500 and (col. 2, lines 38-42). The strip is provided with fastening means (52, 54) such as Velcro and/or adhesive (col. 4, line 20).

Art Unit: 1772

When adhesive is used as the fastening means, it is reusable because the strip is removable and also the various fastener means ' examples are of the reusable type. The intended use phrases such as "for use", etc. have not been given any patentable weight because said phrases re not found to be of positive limitations.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-3, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weightman.

Weightman, as discussed above, fails to each the presence of a liner covering the adhesive fastener. It would have been obvious to one having ordinary skill in the art at the invention was made to provide the adhesive with a liner covering for protecting it from adverse environment such as dirt and use of such release liner is well known and conventional in the adhesive art, as shown in Ratzlaff (discussed above).

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 1772

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

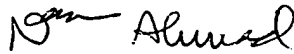
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772
1/5/06

N. Ahmad.
January 5, 2006.